

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/771,519
Attorney Docket No.: A8062

REMARKS

Claims 1-67 are all the claims pending in the application. By this Amendment, Applicant amends claims 1, 9, 14, 15, 21, 29, 34, 41, 49, 54, 61, and 64. Claims 1, 9, 14, 15, 21, 29, 34, 41, 49, 54, 61, and 64 are amended to further clarify the invention and to more particularly point out the invention and not necessarily to overcome the prior art.

Summary of the Office Action

The Examiner withdrew the previous rejections. The Examiner, however, found new grounds for rejecting the claims.

Claim Rejections under 35 U.S.C. 102(e)

Claims 1-67 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,631,381 to Couch et al. (hereinafter "Couch"). Applicant respectfully traverses this rejection and respectfully requests the Examiner to reconsider this rejection in view of the comments, which follow.

Of these claims, only claims 1, 21, 41, and 61 are independent. This response will initially focus on these independent claims. For example, claim 1, among a number of unique features, recites "in response to the receipt of the statement for the transaction, automatically generating a private catalog for the transaction to record information about the objects." The Examiner asserts that claim 1 is directed to a method for executing a statement to manipulate data stored in a data store and is anticipated by Couch.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant's claims. Rejections under 35 U.S.C. § 102 are proper

only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. *See* MPEP § 2131.

Couch discloses an apparatus for integrally referencing a user-generated copy of a catalog in a database system (col. 2, lines 33 to 40 and lines 46 to 65). Catalogs are database organizational information, which is highly utilized especially when the database system has many different users (col. 2, lines 32 to 44). Accordingly, to lessen the burden on the actual database catalog, Couch discloses users generating copies of a catalog and using these user-generated copies to access the database (col. 2, lines 60 to 65).

Specifically, Couch discloses the user interacting via GUI 66 with the report creator 60, graph generator 62, and parameter browser 64 to create a user-generated copy of the catalog (col. 7, line 53 to col. 8, line 47). Then for accessing the database system, Couch discloses a reference module 100. This reference module 100 is configured to receive a user designation of a high level qualifier of a user-generated copy of the catalog 88 and pass the high level qualifier to the catalog querying module 86. In response, the catalog querying module 86, in lieu of querying the catalog 88 for information needed by the query explain program 50, queries a copy 87 of the catalog. Couch further discloses that users are able to make copies of the system catalog 88 and make user-generated copies 87 and 89 thereof. The users may then, rather than referring to the system catalog 88 for every need by a database system component, refer to one of the user generated copies 87 and 89. Thus, the high rate of usage of the catalog 88 is bypassed,

roadblocks at the catalog 88 are avoided, and response time of the database system component (such as the query explain program 50) may be increased (col. 9, lines 3 to 28).

Couch, however, discloses the user generating copies of the catalog, and then using these user-generated copies to access the database by designating which catalog is to be used (col. 9, lines 4 to 19 and lines 38 to 55). That is, Couch fails to disclose automatically generating a copy of the catalog. In Couch, the copies are generated by the user. Moreover, Couch only discloses the user making a certain number of copies prior to querying the database, and then once these copies are created, querying the database using these copies (Fig. 8; col. 10, lines 53 to 62). In other word, in Couch, these user-generated copies are not created in response to a transactional request for which this catalog copy is used. Couch fails to disclose making a copy of the catalog in response to the receipt of the statement for a transaction. On the contrary, in Couch, the copies are created by the user for a later use and not for a transaction. That is, in Couch, the catalog copy is not used by the transaction for which it is created.

Therefore, “in response to the receipt of the statement for the transaction, automatically generating a private catalog for the transaction to record information about the objects,” as set forth in claim 1 is not disclosed by Couch, which lack automatically generating a private catalog, and generating the private catalog in response to the receipt of statement for the transaction. Therefore, claim 1 patentably distinguishes from Couch. Since claims 2-20 depend on claim 1, they are patentable at least by virtue of their dependency.

Independent claims 21, 41, and 61 recite features similar to the features argued above with respect to claim 1. Therefore, those arguments are respectfully submitted to apply with

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equal force here. For at least substantially analogous reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claims 21, 41, and 61. Claims 22-40, 42-60, and 62-67 are patentable at least by virtue of their dependency on claims 21, 41, and 61, respectively.

In addition, with respect to the dependent claims 2-20, 22-40, 42-60, and 62-67, the Office Action indicates that the descriptors were not considered and that the wherein clauses were accorded "little patentable weight". Applicant respectfully submits that it is improper not to consider the "descriptors" and the "wherein" clauses. The "descriptors" and "wherein" clauses are not intended use phrases and should be accorded proper patentable weight.

For example, MPEP § 706.03 states:

The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression (emphasis added).

In the present case, claims 2-20, 41-60, and 62-67 stand unexamined in lieu of a technical rejection dealing with the form of the claims. The Office Action fails to provide full development of reasons e.g., it fails to provide any relevant sections of the MPEP or where

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Applicant can find *the scale of patentable weight*. It is Applicant's understanding that the features of the claims are accorded or not accorded patentable weight. Applicant is unaware of the scale where "little patentable weight" can be accorded to some features. Moreover, MPEP § 2173.01 recites:

A fundamental principle contained in 35 U.S.C. § 112, second paragraph is that applicants are their own lexicographers. ***They can define in the claims what they regard as their invention essentially in whatever terms they choose*** so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions, negative limitations, or ***any style of expression or format of claim*** which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), ***a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought*** (emphasis added).

Accordingly, Applicant respectfully requests the Examiner to withdraw this technical rejection and to examine the dependent claims on their merits. Dependent claims recite additional unique features that provide separate basis for patentability and should be accorded patentable weight.

By way of an example, dependent claims 7-12 recite various unique ways to delete the temporary private copy of the catalog. In Couch, there is no disclosure of ***any deletions*** of the user-generated catalogs. That is, Couch fails to disclose any deletions of the user-generated catalogs. Accordingly, the rejection is improper as it lacks "sufficient specificity" required under

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102. “[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account.” *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985); MPEP § 2131. Therefore, for at least this additional reason, Applicant respectfully submits that claims 7-12 patentably distinguish from Couch.

Moreover, dependent claim 14 recites: “wherein the generating of the private catalog comprises filling in records of the private catalog only with information that relates to tables accessed by the transaction and wherein the private catalog records that relate to tables not accessed by the transaction remain unfilled.” That is, dependent claim 14 further defines the generation recited in claim 1. Couch fails to disclose a partially filled in catalog. Moreover, Couch fails to disclose filling the catalog with information that relates to the transaction. Since in Couch the user catalogs are generated prior to executing the transactions (col. 9, lines 10 to 20), Couch’s catalogs are not partially filled in as it is unknown for which transactions these catalogs will be used. For at least these additional exemplary reasons, claim 14 patentably distinguishes from Couch.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

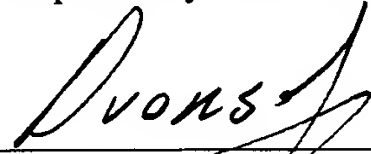
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Respectfully submitted,



Nataliya Dvorson
Registration No. 56,616

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